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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/660,075	09/10/2003	Ryan W. Cuddy	112300-1679	6174
29159 7590 04/30/2008 BELL, BOYD & LLOYD LLP P.O. Box 1135 CHICAGO, IL 60690				
EXAMINER MCCULLOCH JR, WILLIAM H				
ART UNIT 3714		PAPER NUMBER		
NOTIFICATION DATE 04/30/2008		DELIVERY MODE ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PATENTS@BELLBOYD.COM

Office Action Summary

Application No.

10/660,075

Applicant(s)

CUDDY ET AL.

Examiner

William H. McCulloch

Art Unit

3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 January 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29, 31-40 and 42-70 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-29, 31-40 and 42-70 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This action is in response to amendments received 1/16/2008. Claims 1-29, 31-40, and 42-70 are pending in the application, with claims 1, 5, 9, 15, 21, 25, 29, 31-38, 42-45, 48-50, 63, and 67 currently amended, and claims 30 and 41 now cancelled.

Oath/Declaration

2. The declaration is defective. A new declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02. The declaration is defective because it attempts to claim foreign priority under 35 USC §119(a)-(d) to United States patent applications (10/288750 and 09/686409). The declaration should instead claim the benefit of domestic priority under 35 USC §120 to these US applications.

Terminal Disclaimer

3. The terminal disclaimers filed on 1/16/2008 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of U.S. Patents 6,808,545, 6,494,785, 6,786,820, and 6,971,953 have been reviewed and is accepted. The terminal disclaimer has been recorded. As such, the previous obviousness-type double patenting rejections are hereby withdrawn.

Claim Objections

4. Claim 63 is objected to because of the following informalities: the claim recites in part (d), "until the symbol is moved to a locations". Appropriate correction is required.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-29, 31-40, 42-52, 55-56, 59-60, 63-64, and 67-68 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. 6,767,283 to Weiss (hereinafter Weiss).

This rejection was made in a previous Official Action and is maintained and incorporated herein.

Regarding claims 1-28, 51-52, 55-56, and 59-60 Weiss teaches a gaming device and method comprising the following limitations:

- A primary game operable upon a wager by a player (see at least 3:10-67);
- A plurality of locations, which includes a first location (e.g., "Easy Street" in the first bonus), wherein the plurality of said locations form a path (see at least figs. 1 and 3-5, and descriptions thereof);
- A plurality of awards associated with a plurality of said locations along the path (see e.g., elements 41 in fig. 4);
- At least one symbol adapted to make a plurality of moves to a plurality of the locations (see e.g., element 35 in fig. 4);

- At least one setback condition associated with at least one of the locations along the path (see e.g., elements 43 in fig. 4);
- At least one advance condition associated with at least one of said locations along the path (see e.g., elements 41 and 46 in fig. 4);
- A display device operable to display said symbol and the locations (e.g., element 2 in figs. 2-5);
- A processor operable with the display device to control the gaming device (e.g., processor "P" in 3:31-33);
- Repeating the steps of (a) causing the symbol to move to at least one location along the path toward the first location and (b) relocating the symbol to one of the locations along the path further from the first location if the symbol moves to the location associated with the setback condition, until the symbol moves to the first location (e.g., (1) repeatedly playing the bonus game, each time ultimately having a "Go Home" outcome, until the last play results in achieving an "Easy Street" game, and subsequently cashing out, or (2) playing the bonus game one or more times, each time having one or more moves, wherein the symbol never lands on a "Go Home" and ultimately ends on "Easy Street", and subsequently cashing out; see fig. 1 and descriptions thereof);
- Repeating the steps of (a) causing the symbol to move to at least one location along the path toward the first location, (b) providing a player any award associated with the location of the symbol, and (c) relocating the symbol to

one of the locations along the path further from the first location of the symbol moves to the location associated with the setback condition, until the symbol moves to the first location (e.g., (1) repeatedly playing the bonus game, each time ultimately having a "Go Home" outcome, until the last play results in achieving an "Easy Street" game, and subsequently cashing out, or (2) playing the bonus game one or more times, each time having one or more moves, wherein the symbol never lands on a "Go Home" and ultimately ends on "Easy Street", and subsequently cashing out; see fig. 1 and descriptions thereof);

- A processor operable to provide the player at least one award based on the number of different locations the symbol is moved to (see at least 4:1-28);
- A triggering event associated with said game (see at least 3:59-67), wherein after the occurrence of said triggering event: (a) the symbol is moved to at least one location along the path toward the first location (see at least 4:1-28), (b) the symbol is relocated to one of the locations along the path further from the first location if the symbol moves to the location associated with the setback condition (see at least 4:16-19), repeating steps (a) to (b) until the symbol movement terminates when the symbol is moved to the first location (e.g., (1) repeatedly playing the bonus game, each time ultimately having a "Go Home" outcome, until the last play results in achieving an "Easy Street" game, and subsequently cashing out, or (2) playing the bonus game one or more times, each time having one or more moves, wherein the symbol never

lands on a "Go Home" and ultimately ends on "Easy Street", and subsequently cashing out; see fig. 1 and descriptions thereof), and the player is provided a total award based on any award associated with any of the locations the symbol is moved to and the number of locations the symbol is moved to before the symbol moves to the first location (see at least 1:65-2:14 and 4:29-58).

Regarding claims 29, 31-40, 42-50, 63-64, and 67-68, Weiss teaches a gaming device comprising the following limitations in addition to those listed above:

- A primary game operable upon a wager by a player (see at least 3:10-67);
- A first location (see e.g., "Home" location in fig. 4);
- A second location (see e.g., "Easy Street" in fig. 4);
- A plurality of locations, wherein a designated plurality of said locations form a path between said first location and said second location (see at least figs. 1 and 3-5, and descriptions thereof);
- A plurality of awards associated with a plurality of said designated locations along the path (see e.g., elements 41 in fig. 4);
- At least one symbol adapted to make a plurality of moves to a plurality of the locations (see e.g., element 35 in fig. 4);
- At least one setback condition associated with at least one designated location along the path (see e.g., elements 43 in fig. 4);
- At least one advance condition associated with at least one of said designated locations along the path (see e.g., elements 41 and 46 in fig. 4);

- A display device operable to display said symbol and the locations (see e.g., element 2 in figs. 2-5);
- A processor operable with the display device to control the gaming device (e.g., processor "P" in 3:31-33);
- Repeating the steps of (a) causing the symbol to move to different designated locations along the path from the first location toward the second location and (b) relocating the symbol to one of the designated locations along the path toward the first location and further from the second location if the symbol moves to the designated location associated with the setback condition, until the symbol moves to one of the locations that is not between the first location and the second location (e.g., (1) repeatedly playing the bonus game, each time ultimately having a "Go Home" outcome, until the last play results in achieving an "Easy Street" game, and subsequently cashing out, or (2) playing the bonus game one or more times, each time having one or more moves, wherein the symbol never lands on a "Go Home" and ultimately ends on "Easy Street", and subsequently cashing out; see fig. 1 and descriptions thereof);
- Repeating the steps of (a) causing the symbol to move to different designated locations along the path from the first location toward the second location, (b) providing the player any award associated with the location of the symbol, (c) relocating the symbol to one of the designated locations along the path toward the first location and further from the second location if the symbol

moves to the designated location associated with the setback condition, until the symbol moves to one of the locations that is not between the first location and the second location (e.g., (1) repeatedly playing the bonus game, each time ultimately having a "Go Home" outcome, until the last play results in achieving an "Easy Street" game, and subsequently cashing out, or (2) playing the bonus game one or more times, each time having one or more moves, wherein the symbol never lands on a "Go Home" and ultimately ends on "Easy Street", and subsequently cashing out; see fig. 1 and descriptions thereof);

- A processor operable to provide the player at least one award based on the number of designated locations the symbol is moved to before the symbol moves to one of the locations that is not between the first location and the second location (see at least 4:1-28);
- A triggering event associated with said primary game (see at least 3:59-67), wherein after the occurrence of said triggering event the symbol is moved from the first location to one of the designated locations along the path toward the second location (see at least 4:1-28), the symbol is relocated to one of the designated locations along the path toward the first location and further from the second location if the symbol moves to the designated location associated with the setback condition (see at least 4:16-19), the symbol is moved to another one of the locations toward the second location and further from the first location wherein the movement of the symbol terminates if the symbol is

moved to one of the locations that is not between the first location and the second location (see at least 1:65-2:14 and 4:29-58), and the player is provided an award based on the number of designated locations the symbol is moved to before the symbol moves to one of the locations that is not between the first location and the second location (see at least 4:1-28) (e.g., (1) repeatedly playing the bonus game, each time ultimately having a "Go Home" outcome, until the last play results in achieving an "Easy Street" game, and subsequently cashing out, or (2) playing the bonus game one or more times, each time having one or more moves, wherein the symbol never lands on a "Go Home" and ultimately ends on "Easy Street", and subsequently cashing out; see fig. 1 and descriptions thereof).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 53-54, 57-58, 61-62, 65-66, and 69-70 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weiss in view of Admitted Prior Art.

Weiss teaches the invention substantially as described above, but lacks in disclosing operating a game method through a data network including the Internet. In a previous Official Action, the Examiner took Official Notice that it was notoriously well known to those of ordinary skill in the art to operate gaming machines through a data

network including the Internet in order to control gaming devices from a remote location. Applicant has not adequately challenged the facts for which Official Notice was taken and therefore those facts are now considered Admitted Prior Art. See MPEP 2144.03. Thus, the above-mentioned claims are obvious in view of the teachings of Weiss. One of ordinary skill in the art would have been motivated to modify Weiss in order to allow a player to control gaming devices from a remote location.

Response to Arguments

9. Applicant's arguments filed 1/16/2008 have been fully considered but they are not persuasive.

Applicant argues on page 22 of the Remarks that Weiss fails to teach the repetition of certain steps now required by the amended claims (and previously required by e.g., claims 51 and 55). These arguments address all claims rejected under §102(e). The Examiner respectfully disagrees. As described in the grounds of rejection above, Weiss meets each of the 'repetition' steps by the following exemplary situations: (1) repeatedly playing the bonus game, each time ultimately having a "Go Home" outcome, until the last play results in achieving an "Easy Street" game, and subsequently cashing out, or (2) playing the bonus game one or more times, each time having one or more moves, wherein the symbol never lands on a "Go Home" and ultimately ends on "Easy Street", and subsequently cashing out. Each of these examples is described in relation to at least figure 1, and also figure 4. Example (1) stems from the fact that the claims do not require the repetition of steps to happen within the same game, despite Applicant's assumption to the contrary. Example (2) is developed based on the fact that

in the claimed invention, landing on a setback location is optional. Such is evident from the limitation of relocating the symbol "if the symbol moves to the location associated with the setback condition" (see e.g., claim 1). Similar language appears throughout the claimed invention. As such, Weiss anticipates the claimed invention as described above.

Furthermore, Applicant argues on page 23 of the Remarks the rejection of claims under §103 based upon the same arguments as above. For reasons explained above, these arguments are not persuasive and the claimed invention fails to show patentability over the prior art. It is noted that Applicant has not adequately challenged the facts for which Official Notice was taken and therefore those facts are now considered Admitted Prior Art. See MPEP 2144.03. Finally, Applicant argues that "it would not have been obvious to one of ordinary skill in the art to modify Weiss in view of [Admitted Prior Art] to result in such a gaming device/method of operating a gaming device without reasonably being construed as improper hindsight reconstruction". Applicant provides absolutely no evidence or explanation as to why modification of Weiss would be improper hindsight and as such the argument is not persuasive.

In summary, the previous rejection is deemed proper. It is also noted that U.S. 6,315,660 (cited in a previous action) teaches of gaming machines with a board game theme, which includes setback locations on a game board that cause a player symbol to "go back" one or more spaces.

Citation of Pertinent Prior Art

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure and is listed on the attached Notice of References Cited.

Conclusion

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William H. McCulloch whose telephone number is (571) 272-2818. The examiner can normally be reached on M-F 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert E. Pezzuto can be reached on (571) 272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3714

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/W. H. M./
Examiner, Art Unit 3714
4/21/2008

/Robert E Pezzuto/
Supervisory Patent Examiner, Art Unit 3714